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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,299	10/09/2001	Yoshiya Gunji	212289US0PCT	4922

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AJINOMOTO CORPORATE SERVICES, LLC
INTELLECTUAL PROPERTY DEPARTMENT
1120 CONNECTICUT AVE., N.W.
WASHINGTON, DC 20036

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action**Application No.**

09/926,299

Applicant(s)

GUNJI ET AL.

Examiner

David J Steadman

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,5-10,12,13,26 and 27.

Claim(s) withdrawn from consideration: 14-25.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

ADVISORY ACTION

[1] The request for reconsideration in the amendment filed November 23, 2004 has been considered, however the amendment does not place the application in condition for allowance. While the amendment to the claims would appear to overcome the objection as set forth in the Office action mailed July 23, 2004, the amendment has not been entered because the claims as amended present new issues requiring a new search and further consideration. See MPEP § 714.13 regarding non-entry of an after final amendment.

[2] Claims 1, 5, and 7 recite limitations that have yet to be considered in the claims drawn to the elected invention (see, e.g., claim 1 parts a) and b)) and require a new search and further consideration. Further, it is noted that the Markush group recited in claim 5, parts a) and b) reciting aspartokinases and claim 7 recites an improper alternative expression, *i.e.*, the use of "group consisting of" without the use of "and" linking the members of the Markush group. Also, it is noted that it is unclear as to whether "a DNA coding for dihydrodipicolinate synthase that does not suffer from feedback inhibition by L-lysine and a DNA coding for aspartokinase that does not suffer from feedback inhibition by L-lysine" as recited in claim 9 are limited to those DNAs recited in claim 5. Even if the amendment was entered, the written description and scope of enablement rejections under 35 U.S.C. 112, first paragraph, and the rejections under 35 U.S.C. 102(b) and 103(a) may be maintained for the reasons of record.

[3] Applicant's arguments have been fully considered. However, in view of the non-entry of the amendment filed November 23, 2004, applicants' arguments are not found

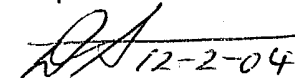
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persuasive to overcome the rejections as set forth in the Office action mailed July 23, 2004 for the reasons of record stated therein.

[4] In view of the non-entry of the amendment, the claim status is as follows:

- Claims 1-2, 5-10, and 12-27 are pending.
- Claims 14-25 are withdrawn from further consideration.
- Claims 1-2, 5-10, 12-13, and 26-27 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (571) 272-0942. The Examiner can normally be reached Monday-Thursday and alternate Fridays from 7:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The FAX number for submission of official papers to Group 1600 is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.


12-2-04
David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1652